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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,408	01/02/2004	Osamu Komoda	501.37387CX1	2840
20457	7590	01/25/2008	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			HASAN, SYED Y	
			ART UNIT	PAPER NUMBER
			2621	
			MAIL DATE	DELIVERY MODE
			01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,408

Applicant(s)

KOMODA ET AL.

Examiner

Syed Y. Hasan

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 - 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 - 28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/02/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 30 is objected to because of the following informalities:

Claim 30 is an independent claim listed after claim 28. There is a missing claim

29. Examiner recommends changing claim 30 to 29.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 13** of this application, claim 1 of U.S. Patent No. 6,701,063 B1 recite a method for recording and/or reproducing image data, the method comprising: recording video data files which comply with a first predetermined standard; recording a first directory for managing the video data files, and which complies with the first predetermined standard; recording data files which are related to ones of the video data files, and which comply with a second predetermined standard which is different from the first predetermined standard; recording a second directory for managing the data files; and recording video managing information to relate ones of the video data files to ones of the data files during a reproduction of the video data files which comply with the first predetermined standard. It is obvious that the method of claim 13 of this application can be practiced by the apparatus of claim 1 of U.S. Patent No. 6,701,063 B1

4. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 14** of this application, claim 2 of U.S. Patent No. 6,701,063 B1 recite the method wherein the video data files are recorded to comply with an MPEG standard, and the data files are recorded with higher resolution than that of the video data files.

5. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 15** of this application, claim 3 of U.S. Patent No. 6,701,063 B1 recite the method wherein the data files are recorded to comply with a JPEG standard

having a higher resolution than that of the video data files.

6. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 16** of this application, claim 4 of U.S. Patent No. 6,701,063 B1 recite the method wherein the video data files comply with a DVD video standard.

7. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 17** of this application, claim 5 of U.S. Patent No. 6,701,063 B1 recite the method according to claim 16, wherein at least ones of the data files are image-still data files having a higher resolution than that of the video data files.

8. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 18** of this application, claim 6 of U.S. Patent No. 6,701,063 B1 recite the method wherein at least ones of the data files are second video data files which comply with a different resolution standard of MPEG than that of the video data files.

9. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 19** of this application, claim 7 of U.S. Patent No. 6,701,063 B1 recite the method wherein the video managing information enables selectable cross-referencing reproduction of ones of the data files related to the subject video data file, during a reproduction of the subject video data file. It is noted that claim 19 of this application is broader than and encompasses apparatus claim 7 of U.S. Patent No. 6,701,063 B1 and, therefore, obviousness-type double patenting rejection is applied.

10. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 20** of this application, claim 8 of U.S. Patent No. 6,701,063 B1 recite the method wherein the video managing information contains address information which enable selectable cross-referencing reproduction of ones of the data files related to the subject video data file. It is noted that claim 20 of this application is broader than and encompasses method claim 8 of U.S. Patent No. 6,701,063 B1 and, therefore, obviousness-type double patenting rejection is applied.

11. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 21** of this application, claim 10 of U.S. Patent No. 6,701,063 B1 recite a video disc recording and reproducing apparatus comprising: a first recording

section to record video data files which comply with a first predetermined standard; a first directory section to record a first directory for managing the video data files, and which complies with the first predetermined standard; a second recording section to record data files which are related to ones of the video data files, and which data files comply with a second predetermined standard which is different from the first predetermined standard; a second directory section to record a second directory for managing the data files; and a video management section to record video managing information to relate ones of the video data files to ones of the data files during a reproduction of the video data files which comply with the first predetermined standard.

It is noted that claim 21 of this application is broader than and encompasses apparatus claim 10 of U.S. Patent No. 6,701,063 B1 and, therefore, obviousness-type double patenting rejection is applied.

12. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 22** of this application, claim 11 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein recorded ones of the video data files comply with an MPEG standard, and recorded ones of the data files have a higher resolution than that of the video data files.

13. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 23** of this application, claim 12 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein recorded ones of the data files comply with a JPEG

standard having a higher resolution than that of the video data files.

14. Claim 24 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 24** of this application, claim 13 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein recorded ones of the video data files comply with a DVD video standard.

15. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 25** of this application, claim 14 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein at least ones of the data files are image-still data files having a higher resolution than that of the video data files.

16. Claim 26 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 26** of this application, claim 15 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein at least ones of the data files are second video data files which comply with a different resolution standard of MPEG than that of the video data files.

17. Claim 27 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 27** of this application, claim 16 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein the video managing information recorded in a subject

video data file enables selectable cross-referencing reproduction of ones of the data files related to the subject video data file, during a reproduction of the subject video data file.

18. Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,701,063 B1.

Regarding **claim 28** of this application, claim 17 of U.S. Patent No. 6,701,063 B1 recite the apparatus wherein the video managing information recorded in a subject video data file contains address information which enable selectable cross-referencing reproduction of ones of the data files related to the subject video data file.

19. Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,701,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding **claim 30** of this application, claim 19 of U.S. Patent No. 6,701,063 B1 recite a video disc comprising: a first recording area having recorded video data files which comply with a first predetermined standard; a first directory area having a recorded first directory for managing the video data files, which directory complies with the first predetermined standard; a second recording area having recorded data files which are related to ones of the video data files, and which data files comply with a second predetermined standard which is different from the first predetermined standard; a second directory area having a recorded second directory for managing the data files; and a video management area having recorded video managing information to relate

ones of the video data files to ones of the data files during a reproduction of the video data files which comply with the first predetermined standard.

It is obvious that the method of claim 30 of this application can be practiced by the apparatus of claim 19 of U.S. Patent No. 6,701,063 B1

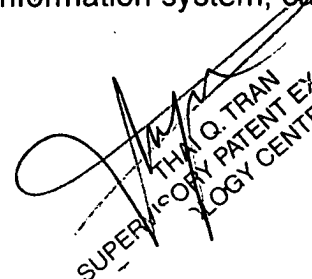
Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Y.H.
01/09/2008


THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
EBC CENTER 2600